

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/645,556	08/25/00	SCHOLKENS	B 02481.1702

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EXAMINER	
BAHAR, M	
ART UNIT	PAPER NUMBER

1617

DATE MAILED:

06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/645,556

Applicant(s)

SCHOLKENS ET AL.

Examiner

Mojdeh Bahar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specifically named ACE inhibitors, does not reasonably provide enablement for “pharmaceutically acceptable derivatives” of the ACE inhibitors. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification does not provide guidance as to which ACE inhibitor derivatives are useful in the claimed method. Moreover, the specification does not set out criteria for one of ordinary skill in the art to be able to distinguish those derivatives that would be useful in the instant method from those that would not be useful. One of ordinary skill in the art would have to perform undue experimentation in order to identify which derivatives of ACE inhibitors would be useful in the claimed method.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "normal" and "low" in claim 2 is a relative term which renders the claim indefinite. The terms "normal" and "low" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. One of ordinary skill in the art would not know how to define normal, neither would one of ordinary skill be able to ascertain the limits of the term "low". Note that, but for subject matter of an issued US patent, essential subject matter cannot be incorporated by reference into claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,5-6,10-12 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sudilovsky (EP 0474438 A1).

Sudilovsky (EP 0474438 A1) discloses employing a composition comprising ceronapril in a method of preventing the onset of cerebrovascular disease such as stroke in a normotensive patient in an amount of 0.5 mg to about 30 mg per day, see particularly claims 4,7 and 11 as well as page 2 lines 8-11.

Claims 3, 7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Tschollar (EP 0426066 A2).

Tschollar (EP 0426066 A2) discloses the use of an ACE inhibitor for preparing a pharmaceutical composition for preventing onset of type II diabetes in a mammalian species, see claim 1. Tschollar (EP 0426066 A2) further discloses captopril, zofenopril, ceranapril, fentiapril and fosinopril, enalapril and lisinopril as suitable ACE inhibitors, see particularly claims 7-11.

Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Maclaughlan et al. (WO 96/24373).

Maclaughlan et al. (WO 96/24373) discloses the employment of ACE inhibitors in a co-therapy in patients susceptible to congestive heart failure, see particularly claims 1-5, 9 and 11.

Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by FDA Orange Book Active Ingredient Detail Record Search.

FDA Orange Book Active Ingredient Detail Record Search discloses a pharmaceutical composition comprising candesartan cilexetil as the active ingredient.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tschollar (EP 0426066 A2).

Tschollar (EP 0426066 A2) teaches the use of an ACE inhibitor for preparing a pharmaceutical composition for preventing onset of type II diabetes in a mammalian species, see

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claim 1. Tschollar (EP 0426066 A2) further discloses captopril, zofenopril, ceranapril, fentiapril and fosinopril, enalapril and lisinopril as suitable ACE inhibitors, see particularly claims 7-11.

Tschollar (EP 0426066 A2) does not teach the employment of the particular ACE inhibitors recited in the claims in its method of preventing onset of type II diabetes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any of the ACE inhibitors recited in the instant claims in Tschollar's (EP 0426066 A2) method of preventing the onset of type II diabetes.

One of ordinary skill in the art would have been motivated to substitute any of the ACE inhibitors recited in the instant claims for captopril, zofenopril, ceranapril, fentiapril and fosinopril, enalapril and lisinopril discussed particularly in Tschollar because based on this reference, all ACE inhibitors would have been reasonably expected to have similar therapeutic effects in a method of preventing the onset of type II diabetes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 from 8:30 a.m. to 6:30 p.m. Monday, Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Mojdeh Bahar
Patent Examiner

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June 8, 2001


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600